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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217708
Party	Defendant da Vinci Kunstlerpinselfabrik Defet GMBH
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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J.B. Marketing International, Inc. Opposer, v. da Vinci Kunstlerpinselfabrik Defet GMBH Applicant.	)	Opposition No. 91217708 Ser. No. 77/555,704 Mark: DA VINCI (Stylized)

APPLICANT'S REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UNDER FED R. CIV. P. 12(b)(6); IN THE ALTERNATIVE, MOTION FOR MORE DEFINITE STATEMENT

In response to Applicant's Motion to Dismiss, Opposer has now withdrawn its fraud claims, conceding that cause of action was not well pled. However, Opposer maintains that its claim under Section 2(d) of the Lanham Act is adequately pled and should not be dismissed. For the reasons set forth below, Opposer's Notice of Opposition remains deficient.

In order to allege a claim under Section 2(d) of the Trademark Act, Opposer must plead and then prove priority of use. T.B.M.P. § 309.03(c)(A); *See also Herbko International Inc. v. Kapa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d 1375 (Fed. Cir. 2002). Moreover, "threadbare recitals of elements of a cause of action, supported by mere conclusory statements" are insufficient to satisfy the pleading requirements. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Covidien LP v. Masimo*, 109 U.S.P.Q.2d 1696, 1697 (T.T.A.B. 2014).

Here, Opposer never sets forth its alleged first use date or any allegation that its mark has been in continuous use in interstate commerce since that date. Opposer contends that the bald assertion that "[o]pposer is the senior user" and that it has "superior rights" is sufficient under

Twombly. To the contrary, these conclusory statements are precisely the sort of "threadbare" assertions that the court in *Twombly* considered insufficient. *Twombly*, 55 U.S. at 570. Moreover, the Board has acknowledged that failing to plead specific facts regarding an opposer's claim of priority may render the pleading deficient. *See e.g.*, *Bayer Consumer Care AG v. Belmora LLC*, 90 U.S.P.Q2d 1587, 1590 (T.T.A.B. 2009) (granting motion to dismiss second amended petition to cancel because claim of priority based on third party importation was insufficient). *Cf. Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, (2007) (finding that a pleading of "analogous use starting January 2006" to be sufficiently specific where opposer's likelihood of confusion claim depended on priority of analogous use).

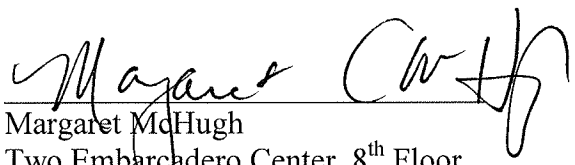
Opposer's unclear claims of priority exacerbate the deficiencies created by the barebones allegations set forth. Initially, Opposer asserted a claim of fraud based on Applicant's claimed date of first use of 1988 in the Application and alleged that evidence later provided to Opposer demonstrated use only back to 1997. Dkt. 1, ¶5-6. This suggests that Opposer's priority claim is based on use prior to 1997 and not on Applicant's claimed date of first use of 1988. But, Opposer also alleges that "prior to 1997 Applicant sold cosmetic brushes in interstate commerce under a trademark different and distinct from Applicant's Mark" and that "Applicant's sales prior to 1997 were so sporadic and minimal as to not constitute bona fide trademark use." Dkt. 1, ¶7. These allegations appear to suggest that Opposer acknowledges that Applicant has used Applicant's Mark prior to any use of Opposer's Mark by Opposer. However, other allegations indicate that Opposer may be basing its claim that it has "superior rights in the DA VINCI mark" on its contention that Applicant's use "has been too minimal to constitute trademark use" and/or that "Applicant has not used Applicant's Mark continuously" since the first use date stated in the Application. *Id.* at ¶15. These conflicting assertions make it entirely unclear whether or not

Opposer has stated a claim under Section 2(d) of the Lanham Act. At a minimum, Opposer should be required to amend the Notice of Opposition to allege facts clearly stating the basis on which it claims priority, including but not limited to the date that Opposer first used its claimed "DA VINCI brand" in interstate commerce, and establishing that it claims continuous use of its mark since that date.

For the reasons stated above and in Applicant's opening brief, Applicant respectfully requests that the Board grant this Motion and dismiss the Notice of Opposition.

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP



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v.	)	Opposition No. 91217708
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da Vinci Kunstlerpinselfabrik Defet GMBH	)	Ser. No. 77/555,704
	)	Mark: DA VINCI (Stylized)
	)	
Applicant.	)	

CERTIFICATE OF SERVICE

A true and correct copy of the attached document has been served on counsel for Opposer via first class mail addressed as follows:

Tal Grinblat
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Dated: October 22, 2014

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